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CERTIFICATE OF MAILING

DATE OF DEPOSIT: October 28, 2004

I hereby certify that the foregoing document is being deposited with the United States Postal Service, First Class Mail, Postage prepaid, on the above-identified date, and is addressed to **Box TTAB**, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Lori Dillon

Lori Dillon

Matter No.: 718259.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Application of 76/499950

Applicant: Sentry Security Fasteners, Inc.

Filed: March 20, 2003

Mark: SENTRY and Design

NOTICE OF APPEAL TO THE TRADEMARK TRIAL AND APPEAL BOARD, WITH REQUEST FOR REMAND

Applicant appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney dated April 28, 2004, finally refusing registration of the above identified trademark. Please debit our Account No. 11-0160 for the filing fee of $100.00 per class, for a total of $200.00, as required by Rule 2.6(a)(18).

Applicant respectfully requests remand of this matter to the Examiner for consideration of a new identification of goods and new information presented in Applicant's response to the final Office Action. The new identification is believed to resolve the Examiner's objections to the prior description of goods. The new information responds to the position of the Examiner taken in discussions concerning the final Office Action. Applicant's Response to the Final Office Action is filed simultaneously with this appeal.

Applicant has cause to believe that remand and a further response to the Examiner may result in withdrawal of the objection, and remove the necessity for this Appeal.

Date: October 25, 2004

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Matter No.: 718259.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sentry Security Fasteners, Inc.

Filing Date: March 20, 2003

Mark: SENTRY and Design

Ser. No.: 76-499950

Office Action No.: Final

Mailing Date: April 28, 2004

Examining Attorney: Dorritt Carroll

Law Office: 116

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

APPLICANT'S RESPONSE TO FINAL OFFICE ACTION

Applicant, Sentry Security Fasteners, Inc. respectfully submits its response to the final Office Action. Applicant submits a revised identification of goods. Applicant further submits that its mark is not in conflict with the cited registrations, and requests that the Examiner consider key factors omitted from the initial analysis. Applicant includes evidence pertinent to distinguishing the use and channels of trade of the cited registrations from Applicant's use and channels of trade.

1. Amendment to Goods Description.

Applicant adopts the following amended description of goods consistent with the Examiner's request:

> Anchoring systems, namely metal fastening anchors; metal hardware, namely rivets, screws, threaded inserts for metal screws and metal bolts, threaded rods and nuts; metal door frames and hardware, namely keys for locks, cylinders for locks, hinges, locks, hinge plates, door closers and door kick plates; metal fasteners, namely screws, bolts, pins, anchors, studs, and rods; metal locking mechanisms and their structural components namely locks, keys, and accessories, electrical connectors; and metal window frames, all for wholesale and institutional construction distribution, in International Class 6.
>
> Power tools and parts and fittings therefor, namely riveting tools, rotary files, drills, taps, dies for use with machine tools, and screwdrivers, all for wholesale and institutional construction distribution, in International Class 7.

The description has been amended in accord with the Examiner's remarks. Moreover, it also comports with the Applicant's other registered mark, U.S. Registration No. 2,888,398.

Applicant has restricted its identification of goods and services to wholesale and institutional construction distribution to better describe Applicant's channels of trade. Applicant's goods sold under the SENTRY and Design mark are sold either directly to institutional builders for use in construction of institutional buildings or at wholesale for resale under a different trademark. Retail customers do not encounter Applicant's mark on goods offered in retail stores. Applicant's clientele is limited to sophisticated wholesalers and institutional construction professionals. Applicant submits that its channels of trade distinguish its mark from the marks cited as conflicting, as more fully discussed below.

2. New Evidence.

From discussion with the Examiner, it became apparent that while there are many SENTRY marks within the relevant field, the Section 2(d) refusal is based on the Examiner's concern that Applicant's goods and the goods covered by the cited registrations may potentially be encountered in the same channels of trade. Applicant submits evidence that the channels of

trade are in fact distinct. As noted above, Applicant's trade is specifically targeted to highly sophisticated professionals and specialists in particular fields. Applicant further submits that the registered marks cited in the Office Action are limited to retail distribution through Sentry Hardware stores. Applicant submits evidence of such as Exhibit A, describing the "Sentry Program" of the registrant, which includes decor and operation of retail stores as well as distribution of branded goods to consumers.

3. Applicant's Mark is Not Likely to Cause Confusion.

The Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), concluding that Applicant's mark, when used on or in connection with the identified goods, so resembles the cited marks as to be likely to cause confusion, to cause mistake, or to deceive. Applicant requests the Examining Attorney withdraw the refusal to register. Numerous factors impact the analysis[1]; and Applicant respectfully submits that the Examiner has disregarded relevant points.

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1 In determining whether there is a likelihood of confusion under Section 2(d), one must consider the following factors, when of record:

(a) The similarity or dissimilarity of the marks in their entireties as to appearance sounds connotation and commercial impression.

(b) The similarity or dissimilarity and nature of the goods or goods as described in the application or registration or in connection with which a prior mark is in use.

(c) The similarity or dissimilarity of established, likely-to-continue trade channels.

(d) The conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing.

(e) The fame of the prior mark (sales, advertising, length of use).

(f) The number and nature of similar marks in use on similar goods.

(g) The nature and extent of any actual confusion.

(h) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

(i) The variety of goods on which a mark is or is not used (house mark, "family mark", product mark).

(j) The market interface between applicant and the owner of the prior mark: (a) a mere "consent" to register or use; (b) agreement provisions designed to preclude confusions, i.e., limitations on continued use of the marks by each party; (c) assignment of mark, application, registration and good will of the related business; (d) latches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

(k) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(l) The extent of potential confusion, i.e., whether de minimis or substantial.

(m) Any other established fact probative to the effect of use.

Regarding Examiner's continued refusal based on Registration Numbers 2,662,958 and 1,282,910, Applicant respectfully requests that Examiner withdraw her refusal based on the merits stated below. Applicant submits with respect that the analysis contained in the Office Action failed to consider important factors, including in particular: (a) Applicant's mark considered in its entirety differs significantly from the cited marks; (b) the channels of trade for Applicant's mark and the cited marks are not the same; and (c) Applicant's decade of use of its mark without confusion demonstrates that future confusion is not likely.

A. The Office Action Failed to Consider Applicant's Mark in its Entirety.

In assessing a likelihood of confusion, the marks must be considered in their entireties and must be considered in connection with the particular goods for which they are used. *In re National Data Corp.*, 224 U.S.P.Q. 749 (Fed. Cir. 1985); Trademark Manual of Examination Procedures (T.M.E.P.) § 1207.01. While Applicant's mark and the cited registrations contain the term "SENTRY," significant distinguishing features between the marks and channels of trade mandate that confusion is not likely.

Particularly where there are numerous other coexisting "SENTRY" registrations, the distinctions between the marks are important to the analysis. The Examiner's analysis considered the term "SENTRY," but downplayed the significance of Applicant's unique design and presentation. While it is true that the word portion of a mark must be given due consideration, the composite mark does impact buyers, especially sophisticated buyers such as the professional institutional builder or wholesale reseller, the consumers of Applicant's goods.

In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973); TMEP § 1207.01. These evidentiary elements are not set forth above in order of merit. Rather, each may play a dominant role from case to case. *Id.*

Further, the co-existence of so many "SENTRY" marks makes confusion unlikely, especially where the goods are distributed to different customers in different channels of trade. Applicant previously provided evidence of other registrations for "SENTRY" in fields related to the marks cited as conflicting. Applicant now supplements the original submission with copies of registered marks containing "SENTRY." The Trademark Office has found these registrations distinguishable from one another. Likewise, customers, especially sophisticated professionals making business purchases, are well able to distinguish between Applicant's mark and the cited marks.

This situation is governed by *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984), in which the Trademark Trial and Appeal Board (T.T.A.B.) held that third party registrations are competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. Such marks containing a common term or feature are distinguished by remaining portions of the marks. In *In re Hamilton Bank*, the Board determined that the use of the term KEY by various parties in the financial field was grounds to reverse a likelihood of confusion refusal.

Moreover, a composite mark creates a distinct impression from a single element used as a separate mark. For example, in *Standard Brands, Inc. v. Peters*, 191 U.S.P.Q. 168 (T.T.A.B. 1975) the Board held that the addition of the term CORN to ROYAL rendered CORN ROYAL registrable despite a pre-existing registration for ROYAL for similar goods. The Board observed that:

> . . . unlike in the case of arbitrary or unique designations, suggestive or highly suggestive terms, because of their obvious connotation and possible frequent employment in a particular trade

> as part of trade designations, have been considered . . . weak marks, and the scope of protection afforded these marks have been so limited as to permit the use and/or registration of the same mark for different goods or a composite mark comprising the term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods. *Id.* at 172.

A further illustration can be found in *In re The Hearst Corporation*, 25 U.S.P.Q. 2nd 1239 (Fed. Cir. 1992). The Federal Court of Appeals reversed the Trademark Trial and Appeal Board's decision that VARGA GIRL for "calendars" was confusingly similar to the registered mark VARGAS for **identical** goods, namely: "calendars, posters, greeting cards, paintings, limited-edition prints, books of images and art work and art prints." The Court held that the marks VARGA GIRL and VARGAS are sufficiently different in sound, appearance, connotation and commercial impression to negate likelihood of confusion. The Court of Appeals said that the Board improperly stressed the portion VARGA and diminished the portion GIRL, and "inappropriately changed the mark," stating that the mark VARGA GIRL derives "significant contribution" from the term GIRL. Similarly, the Applicant's mark derives significant contribution from its significant design feature, which the Examining Attorney impermissibly diminishes when comparing Applicant's mark to the cited marks.

The Office Action also suggests that the SENTRY registrations cannot coexist with Applicant's mark but disregards that the registrations already coexist with numerous marks containing SENTRY. Applicant uses SENTRY as a portion of a distinct mark in a specialty field, not in conflict with the cited marks. The plethora of coexisting registrations containing or consisting of "SENTRY" indicates that the Trademark Office has historically recognized that the public can and does distinguish between the various marks without difficulty

or confusion. Applicant submits that its mark can also peacefully coexist and has done so for many years.

B. Applicant's Channels of Trade Are Distinct From the Cited Marks.

In further support of registration, Applicant notes that the Examining Attorney failed to consider the conditions under which, and the buyers to whom, sales are made. In *Mead Data Central, Inc. v. Toyota Motor Sales USA, Inc.*, 9 U.S.P.Q. 2d 1442, 1449 (S.D. N.Y.), the Court elaborated on the importance of this factor to the likelihood of confusion analysis, saying that "typically, sophistication of the buyer is a factor that will weigh against finding a likelihood of confusion." This factor is particularly pertinent to the instant case Applicant has amended its description of goods to clarify that its channels of trade are wholesale and institutional construction. Its mark is not encountered by retail consumers, but only by sophisticated professionals. Wholesale purchasers looking to resell goods under a house brand generally order large quantities of product, and are therefore more discriminating and sophisticated about purchases. Direct purchasers on large institutional construction jobs are likewise experienced professionals with sophisticated knowledge of the market.

Given this clientele, it is clear that confusion is not likely because Applicant's customers are sophisticated enough to distinguish between Applicant's mark and other marks which share one term with it. Further, Applicant's mark and the cited marks are not likely to be encountered by the same customers because of the differences in goods, and Applicant's specialty fields of trade. Considering these facts, Applicant submits that confusion is not likely.

C. Absence of Confusion For Over Ten Years.

As further evidence that confusion is not likely, Applicant submits that its mark has been in use for over ten years without any incident of confusion. Applicant notes that the likelihood of confusion analysis under duPont includes concurrent use without actual confusion. Yet, the Office Action did not take this factor into account. In this case, the coexisting use is so extensive, it must be given considerable weight. More than a decade of coexistence with the cited marks demonstrates that confusion has not occurred and is not likely to materialize in the future. The Examiner truly need not speculate whether confusion is "likely," as ten years of experience show decisively that it is not. Applicant accordingly submits that the objections should be withdrawn and its mark approved for publication.

Respectfully submitted,

Date: October 28, 2004

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EXHIBIT
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